

## REMARKS

### I. Introduction

This paper is responsive to the Office Action mailed November 22, 2006. Claims 1-35 are pending in the application and currently stand rejected. The Office Action indicates that applicants' arguments with respect to Claims 1-35 were considered, but were moot in view of the new grounds for rejection.

In particular, Claims 1-6, 9, 11-16, 19, 21-24, 27, and 29-35 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2003/0063575, to Kinjo (hereinafter "Kinjo"), and U.S. Patent Application Publication No. 2003/0115152, to Flaherty (hereinafter "Flaherty"). Claim 7 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kinjo and Flaherty, and further in view of U.S. Patent No. 6,611,881, to Gottfurcht et al. (hereinafter "Gottfurcht"). Claim 8 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kinjo and Flaherty, and further in view of U.S. Patent Application Publication No. 2002/0107861, to Clendinning et al. (hereinafter "Clendinning"). Claim 10 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kinjo and Flaherty, and further in view of U.S. Patent No. 5,818,028, to Meyerson et al. (hereinafter "Meyerson"). Additionally, Claims 12 and 15-28 were rejected under the same rationale as Claims 1-11, 13, 14, and 29-35 as having similar limitations.

Pursuant to 37 C.F.R. § 1.111 and for the reasons set forth below, applicants request reconsideration and allowance of this application. Prior to discussing the reasons why applicants believe that the present application is in condition for allowance, an Interview Summary is presented.

### II. Interview Summary

Applicants thank the Examiner for taking time on January 31, 2007, to participate in an in-person interview. The interview was conducted in light of the Office Action rejecting

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Claims 1-35. Participating in the January 31, 2007, interview were Examiner Ranodhi Serrao, Examiner Kenneth Coulter, and applicants' representatives, Maria Anderson and Sunah Lee. The discussion in the interview was directed to the distinction between amended Claim 1 and the prior art, particularly the citation of a "second retail entity" from which the selected item is available for purchase.

III. Claim Rejections Under 35 U.S.C. § 103(a)

A. Independent Claim 1

Claim 1 is directed to a method for communicating information regarding a selected item to a user present at the location of a first retail entity. As recited in Claim 1, the method specifically requires "while the user remains present at the location of the first retail entity, which first retail entity is different than a second retail entity, the second retail entity: ... using the identifying data to obtain item information associated with the selected item, wherein the selected item is available for purchase from the second retail entity." The method further requires "communicating the item information from the second retail entity to the imaging device for delivery to the user." These elements are not taught or suggested by Flaherty as the Office Action asserted.

Flaherty and Kinjo Fail to Teach "Second Retail Entity"

Applicants respectfully submit that Flaherty fails to teach at least a "second retail entity" that uses "the identifying data to obtain item information associated with the selected item" and from which "the selected item is available for purchase," as recited in Claim 1. Instead, Flaherty merely teaches an electronic coupon server providing coupons to two-way communication devices.

The Office Action relied on paragraph [0014] and paragraph [0020] of Flaherty for teaching the "second retail entity." However, the cited paragraphs are directed to a "mobile communication server" for distributing retail coupons (paragraph [0014] of Flaherty) or a server

"capable of accessing the electronic coupon clearinghouse and receiving selected electronic coupons." (Paragraph [0020] of Flaherty.) The electronic coupon server in Flaherty is fundamentally different from the "second retail entity" from which "the selected item is available for purchase," as recited in Claim 1.

Further, Flaherty does not teach or suggest the electronic coupon server that uses "the identifying data to obtain item information associated with the selected item" and from which "the selected item is available for purchase."

For these reasons, Flaherty does not teach or suggest a "second retail entity" that uses "the identifying data to obtain item information associated with the selected item" and from which "the selected item is available for purchase," as recited in Claim 1. Moreover, Kinjo also fails to teach the above-mentioned elements, as acknowledged by the prior Office Action (mailed June 19, 2006).

Accordingly, Flaherty and Kinjo, alone or in combination, fail to disclose or suggest "the second retail entity: ... using the identifying data to obtain item information associated with the selected item, wherein the selected item is available for purchase from the second retail entity" "while the user remains present at the location of the first retail entity, which first retail entity is different than a second retail entity," as recited in Claim 1.

Flaherty and Kinjo Fail to Teach "Receiving ... Image That Contains Identifying Data"

As correctly noted by the Office Action, Claim 1 recites an element "receiving an image from the user using an image device, wherein the image contains identifying data associated with the selected item as provided by the first retail entity" which is not taught or suggested by Flaherty. As mentioned above, Flaherty fails to teach a "second retail entity" and, thus, Flaherty also fails to teach the "second retail entity" for "receiving an image from the user using an image device, wherein the image contains identifying data associated with the selected item as provided by the first retail entity."

Applicants respectfully submit that Kinjo also fails to teach the above-mentioned elements. Kinjo is directed to an order processing apparatus for ordering an object featured in a displayed image. For instance, a consumer watching television may photograph an object displayed on the television screen using a portable device. The image, together with information representing an order for the object, is sent from the portable device to the order processing apparatus. The object is identified by comparing the sent image with an original image as broadcast, and the order for the object is processed. (See the Abstract and paragraphs [0009]-[0010] in Kinjo.) However, there is nothing in Kinjo to suggest that the image should be received by a second retail entity.

Moreover, while applicants do not agree that these references can be properly combined, Kinjo fails to make up the defects of Flaherty. Even if applicants assume that Flaherty's teaching of a coupon server and Kinjo's teaching of receiving images can be combined, that combination fails to teach the above-mentioned elements since, at best, that combination would result in a system where a user provides an image of a specific item for receiving coupons for other items for which manufacturers and stores have made coupons available.

Accordingly, Flaherty and Kinjo, alone or in combination, also fail to disclose or suggest the "second retail entity" for "receiving an image from the user using an image device, wherein the image contains identifying data associated with the selected item as provided by the first retail entity," as recited in Claim 1.

Under Section 103, a *prima facie* case of obviousness is established only if the cited references, alone or in combination, teach each of the limitations of the recited claims. *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993). For these reasons, the cited and applied references, alone or in combination, fail to disclose or suggest each limitation recited in Claim 1. Accordingly, applicants respectfully submit that amended Claim 1 is now allowable and request a withdrawal of the Section 103 rejection.

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B. Dependent Claims 2-10

As discussed above, the combination of Kinjo and Flaherty fails to teach each and every element of independent Claim 1. Dependent Claims 2-10 ultimately depend from independent Claim 1 and, thus, Claims 2-10 are likewise allowable over Kinjo and Flaherty for the reasons discussed above in connection with Claim 1. Claims 2-10 also include a number of recitations not disclosed, taught, or suggested by the cited and applied prior art references, particularly when the recitations are considered in combination with the recitations of the claims from which these claims depend.

C. Independent Claim 12

Claims 12 and 15-28 were rejected under the same rationale as Claims 1-11, 13, 14, and 29-35 as having similar limitations. (Office Action, page 10.)

In view of the above-described reasons with respect to Claim 1, applicants respectfully submit that Kinjo and Flaherty fail to teach all of the elements of Claim 12. In particular, neither Kinjo nor Flaherty teach a server comprising "a subsystem configured to use the identifying data to obtain item information associated with the selected item available for purchase from the second retail entity, wherein the item information is obtained from at least one resource," especially in light of the feature that states that the server is "operated by a second retail entity that is different than the first retail entity," as recited in Claim 12. Flaherty and Kinjo also fail to teach "a server operated by a second retail entity" having "a subsystem configured to receive an image from the user using the imaging device."

Similar to the analysis of Claim 1, the disclosures of Kinjo and Flaherty, alone or in combination, fail to teach all of the elements of Claim 12. Accordingly, Claim 12 is allowable over the cited prior art references.

D. Dependent Claims 13-21

Dependent Claims 13-21 ultimately depend from independent Claim 12. As discussed above, the combination of Kinjo and Flaherty fails to teach each of the elements of independent Claim 12. Claims 13-21 also include a number of recitations not disclosed, taught, or suggested by the cited and applied prior art references, particularly when the recitations are considered in combination with the recitations of the claims from which these claims depend. For the above-mentioned reasons, Claims 13-21 are likewise allowable over Kinjo and Flaherty.

E. Independent Claim 22

Claim 22 recites elements similar to those of Claim 1. Specifically, based on the above analysis of Claim 1, applicants respectfully submit that Flaherty and Kinjo both fail to teach all of the elements of Claim 22. In particular, Flaherty and Kinjo both fail to teach a "second retail entity" for operating the computer-executable component for "using the identifying data to obtain item information associated with the selected item, wherein the selected item is available for purchase from the second retail entity." For at least this reason, the rejection of Claim 22 should be withdrawn.

In addition, Claim 22 has been amended to recite that the computer-executable component for communicating item information for a selected item available for purchase is "executed by a second retail entity that is different than a first retail entity." This is not taught or suggested in the cited art. Flaherty does not teach or suggest the coupon server is "executed by a second retail entity that is different than a first retail entity." Kinjo, as well, does not teach or suggest a computer-executable component "executed by a second retail entity that is different than a first retail entity," as claimed. Accordingly, amended Claim 22 is allowable over the prior art.

F. Dependent Claims 23-29

Claims 23-29 are dependent on Claim 22 and thus are allowable for the reasons discussed above in connection with Claim 22. Claims 23-29 also include a number of recitations not disclosed, taught, or suggested by the cited and applied prior art references, particularly when the recitations are considered in combination with the recitations of the claims from which these claims depend.

G. Independent Claim 30

The Office Action acknowledged that Flaherty fails to teach the elements of: "communicating an image containing the identifying data; an input device for capturing an image of the selected item that contains identifying data associated with the selected item as provided by the first retail entity; a storage medium for storing said identifying data and program instructions for processing the image; a processing unit communicatively coupled to the input device, while the user remains at the location of the first retail entity; the output device and the storage medium for executing the program instructions that process the image." (Office Action, pages 5-6.) However, the Office Action asserted that Kinjo teaches the above elements in paragraphs [0126], [0133], [0134], and [0144]. (Office Action, page 6.) Applicants respectfully disagree.

Claim 30 claims "[a]n integrated portable apparatus for obtaining item information for a selected item available for purchase at a location of a first retail entity." The apparatus comprises, among other things, "an input device for capturing an image of the selected item," and "an output device for outputting item information for the selected item as obtained from a second retail entity that is different than the first retail entity." As the Office Action acknowledged, Flaherty fails to teach "obtaining the item information for the selected item by communicating the image containing the identifying data to the second retail entity, wherein the selected item is available for purchase from the second retail entity," as recited in Claim 30.

(Office Action, page 5.) Applicants respectfully submit that Kinjo fails to make up the defects of Flaherty. As stated in the above-identified reasons with respect to Claim 1, Kinjo, for its part, also does not teach or suggest "communicating the image containing the identifying data to [a] second retail entity wherein the selected item is available for purchase from the second retail entity." Thus, the combination of the teachings of Kinjo and Flaherty cannot produce any meaningful result that would render Claim 30 obvious. For the above reasons, as well as the reasons presented with respect to Claim 1, applicants submit that Claim 30 is patentable over the cited art.

H. Dependent Claims 31-35

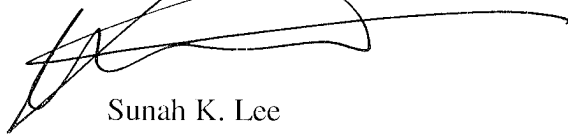
Dependent Claims 31-35 depend from independent Claim 30. As discussed above, the combination of Kinjo and Flaherty fails to teach each of the elements of independent Claim 30. Accordingly, Claims 31-35 are likewise allowable over Kinjo combined with Flaherty.

CONCLUSION

In view of the foregoing claim amendments and remarks, applicants submit that all of the pending claims in the application are in condition for allowance. Reconsideration of the application and allowance of the claims is solicited. If the Examiner has any remaining questions or comments concerning this matter, the Examiner is invited to contact applicants' undersigned attorney at the number provided below.

Respectfully submitted,

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